



CROSS-REFERENCE TO RELATED APPLICATION

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TO 2800 MAIL ROOM

B1
The instant application claims priority to U.S. Provisional Patent Application
Serial No. 60/160,390, filed October 19, 1999.

IN THE CLAIMS

Please amend claim 1 by substituting the following claim therefor (sample claim showing amendment is shown on the last page of this amendment).

Amend B2
O1
Claim 1. (Twice Amended) An exterior mirror for a vehicle comprising:
a mirror housing assembly including a reflective element normally facing in a
direction for viewing rearward; and
a folding mechanism operably folding and maintaining the mirror in forward direction
whereby the overall width dimension of the vehicle is reduced.

REMARKS

Claims 1-19 are pending in the application.

Claims 2-5, 7-9 and 11-19 have been withdrawn from consideration.

Claims 1, 6 and 10 stand rejected.

Claim 1 has been amended. Support for this amendment can be found throughout the specification and drawings, as originally filed.

The specification has been amended to include a reference to, and claim of priority to, U.S. Provisional Patent Application Serial No. 60/160,390, filed October 19, 1999. The priority claim to U.S. Provisional Patent Application Serial No. 60/160,390 was made in the

previously filed Declaration and Power of Attorney. Applicant avers that no new matter has been introduced into the specification by virtue of this amendment.

This response is submitted after receipt of a final office action. Applicant submits that the response places the application in a condition for allowance, or alternatively, in better condition for appeal.

REQUEST FOR WITHDRAWAL OF FINALITY OF THE OFFICE ACTION

The Examiner has rejected the instant application over new art previously uncited in the prosecution of the patent application. The Examiner asserted that Applicant's amendment necessitated the new ground(s) of rejection presented in the instant final office action.

Applicant respectfully traverses the finality of the instant office action and requests withdrawal of the finality of the instant office action.

The amendments made by Applicant should reasonably have been expected to be claimed by the Examiner, because they further define features that are clearly shown and described in the specification and drawings. Additionally, claim 10 was not amended in the instant application, but has now been rejected over previously uncited new art. The MPEP § 706.07 (a) states:

"Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations

which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. § 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element". (emphasis added)

It is respectfully submitted that in the present application claims have been rejected which were not amended by the applicant, namely dependant claims, over new art of record. Finality of rejection of claims 1, 6 and 10 is improper.

The changes to the claims include limitations related to the folding mechanism being able to selectively fold and maintain the mirror between a forward direction and a rearward direction.

It is respectfully submitted that the specification, entire set of drawings in the application, along with the dependent claims, show that this limitation should reasonably have been expected to be claimed in accordance with MPEP § 706.07(a) and, therefore, a final rejection in the present application is not proper. Applicant respectfully requests reconsideration of the Examiner's rejection herein over the newly previously uncited art and withdrawal of the finality of the action.

REJECTION UNDER 35 U.S.C. 102(b)

Claims 1 and 6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hoek (U.S. Patent No. 5,903,402).

Applicant respectfully traverses the rejection.

The law is clear that anticipation requires that a single prior art reference disclose each and every limitation of the claim sought to be rejected. 35 U.S.C. 102(b).

The law is also clear that a claim in dependent form shall be construed to incorporate

all the limitations of the claim to which it refers. 35 U.S.C. 112, fourth paragraph.

Applicant submits that Hoek '402 does not qualify as prior art under 35 U.S.C. 102(b). In the instant response, Applicant has submitted a timely claim of priority to U.S. Provisional Patent Application Serial No. 60/160,390 that was filed on October 19, 1999. For purposes of 35 U.S.C. 102(b), Hoek ('402) has an effective publication date (i.e., issue date) of May 11, 1999, which is less than one year prior to October 19, 1999. Accordingly, the 35 U.S.C. 102(b) rejection of claims 1 and 6 is improper and should be withdrawn.

Accordingly, the 35 U.S.C. 102(b) rejection of claims 1 and 6 has been overcome.

Furthermore, the Applicant submits that Hoek ('402) does not render claims 1 and 6 obvious.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon

this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

Without admission that any amendment is required, and in the interests of expediting prosecution of the instant application, Applicant has amended claim 1 to recite that an exterior mirror for a vehicle comprises (1) a mirror housing assembly including a reflective element normally facing in a direction for viewing rearward, and (2) a folding mechanism operably folding and maintaining the mirror in a forward direction whereby the overall width dimension of the vehicle is reduced. Such structure is not disclosed or suggested by Hoek ('402).

It is Applicant's understanding that Hoek ('402) merely discloses a telescoping mirror that can be positioned in a rearward direction (relative to the normal operating position of the mirror) so as to enable the driver of the vehicle to observe a load being towed by the vehicle. Additionally, there is no disclosure or suggestion by Hoek ('402) that the mirror be capable of also being positioned in a forward direction (relative to the normal operating position of the mirror), as the stated purpose of Hoek ('402) is to enable enhanced rearward viewing only (see especially column 6, lines 59-66). Further, there is no mention by Hoek ('402) that the disclosed mirror is to be positioned so as to decrease the overall width of the vehicle, e.g., for purposes of safely transporting the vehicle without damaging the mirrors during transit.

Therefore, one of ordinary skill in the art would not look to Hoek ('402) for guidance on constructing a mirror that is capable of being directed forwardly relative to the normal operating position of the mirror.

Accordingly, Applicant submits that Hoek ('402) does not render claims 1 and 6 obvious.

REJECTION UNDER 35 U.S.C. 103(a)

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hoek (U.S. Patent No. 5,903,402) in view of Hoek (U.S. Patent No. 6,116,743).

Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over Hoek ('402) for at least the reasons stated above, dependent claim 10, a claim that is properly dependent on independent claim 1, is likewise allowable. Furthermore, the citation of Hoek ('743) does not cure the previously discussed deficiencies in the teachings of Hoek ('402).

Accordingly, the 35 U.S.C. 103(a) rejection of claim 10 has been overcome.

CONCLUSION

It is respectfully submitted that the claims, as amended, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, applicant submits that the pending claims are allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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TC-2800 MAIL ROOM

In the Claims

Claim 1. (Twice Amended) An exterior mirror for a vehicle comprising:

a mirror housing assembly including a reflective element normally facing in a direction for viewing rearward; and

a [first] folding mechanism [which provides for] operably folding and maintaining the mirror in forward direction [for reducing] whereby the overall width dimension of the vehicle is reduced.